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09/920,386	08/01/2001	Greg Eippert	27228/04002	4401

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

**Office Action Summary**

Application No.

09/920,386

Applicant(s)

EIPPERT, GREG

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 18 and 19 have been added.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of: an advertising

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markings corresponding one of the indicators of medications as stated in Claim 6; a “color coded cap corresponding to the color shaded row”, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley (5,995,938) in view of Mayfield (5,261,702).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers

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("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one or more color coded medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39). Whaley further discloses in Fig. 7 and 11, a reminder system comprising medical markings (138, 142, 150) representing a time period within a day.

However, Whaley does not disclose: wherein one or more rows are color shaded with different colors; medications related to ophthalmology; markings designate which eye to place medication within.

Mayfield discloses in Fig. 2, a reminding system comprising rows (A) and columns (B), wherein rows and columns are filled in by filling in individual cells with colors as necessary Col. 7, lines 6-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Mayfield for the purpose of color coding the matrix.

In regards to **Claims 4 and 5**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the sheet representing any desirable information, since it would only depend on the intended use (i.e the type of medical condition) of the end user and the desired information (i.e. medications) to be displayed. Further,

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it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

4. Claims 6, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Mayfield, and further in view of North et al (5,992,888).

Whaley as modified by Mayfield discloses a reminder system comprising all the elements as claimed in Claims 1 and 3, and as set forth above.

However, Whaley as modified by Mayfield does not disclose: advertising markings and coupons which correspond to one of the medication indicators.

North et al discloses in Fig. 1-4 and 9, a reminder system comprising advertising markings (11) and coupons (16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's reminder system to include advertising markings and coupons in place of the indicia markings as taught by North et al for the purpose of providing an advertising method which focuses specific advertising material to a preselected market segment.

Regarding the advertising markings corresponding to one of the medication indicators, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable advertising indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. The advertising markings and coupons of North et al are capable of corresponding to medication indicators and to a pharmacy depending on the indicia printed in the advertising area and on the coupons.

In regards to Claim 18 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many areas as desired to place advertising markings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Cutting (4,295,664).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers

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("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one or more color coded medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39). Whaley further discloses in Col. 9, lines 64-67 that the chart can be multiple pages depending on the number of medications.

However, Whaley does not disclose a tablet of multiple sheets of paper.

Cutting discloses in Fig. 1-4, a system reminder comprising a tablet of multiple sheets.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mayfield's system to include a tablet of multiple sheets as taught by Cutting for the purpose of track of multiple records of information.

### ***Response to Arguments***

6. Applicant's arguments filed on July 17, 2003 have been fully considered but they are not persuasive.

In regards to applicant's argument that applicant's invention does not teach the use of a computer tools to provide the system, the examiner submits that the features upon which applicant relies (i.e., an apparatus to generate the system) are not recited in the rejected claim(s).



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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to applicant's arguments that the prior art does not disclose rows which are shaded in color, the examiner submits that the prior art (Mayfield) does indeed disclose wherein rows and columns are filled in with colors in individual cells. Applicant must note that the claims do not disclose that the entire row or column had to be completely filled or shaded in.

Therefore, the examiner has maintained the rejections.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 4, 2003



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